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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,707	08/02/2001	Ben Byrd	41872-206195	6769
7590	12/30/2005		EXAMINER	
J. Michael Boggs Kilpatrick Stockton LLP 1001 West Fourth Street Winston-Salem, NC 27101-2400			PATTERSON, MARIE D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/920,707	BYRD, BEN	
	Examiner Marie Patterson	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 May 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-5,7-18,20-29 and 31-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5,7-18,20-29 and 31-34 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 7, 9-12, 14-18, 20, 22-25, 27-29, and 32-34 are rejected under 35 U.S.C. 103(a) as being under 35 U.S.C. 103(a) as being unpatentable over Berger (5084988).

Berger shows shoe soles and method of using shoe soles having a heel indicator (boundary between elements 4 and 5), and a plurality of calibrated lines (6 and boundary between elements 3 and 5) with indicia comprising calibrated numbers and/or lines (6 and 7, see column 3 lines 1-10) and since a plurality of calibrated lines and numbers are present this inherently is a "range of sizes" substantially as claimed except for the exact indicia. Standard shoe sizes are a type of well known and conventional calibrated marking. It is also noted that "Where sole distinction set out in the claims over prior art is in printed matter, there being no new feature of physical structure and no new relation of printed matter to physical structure, such claims may not be allowed; it is only where claims define either new features of structure or new relations of printed matter to structure, or both, which new features or new relations give rise to some new and useful function, effect, or result, that claims may be allowed" and "sole different over art being in printed matter (indicia), different is substance, language, or meaning of the same whether generally accepted or arbitrary, cannot serve to impart patentability". (Ex

parte Gwinn, 112 USPQ 439-449). It would have been obvious to use any calibrated markings, including the well known and conventional shoe size calibrated markings (especially since the article is a shoe), for the calibrated lines/indicia on the shoe sole and in the method of Berger to allow the user to easily locate a shoe in the right shoe size range.

3. Claims 8, 13, 21, 26, and 31 are rejected under 35 U.S.C. 103(a) as being under 35 U.S.C. 103(a) as being unpatentable over Berger in view of either Rosen (4931773) or Sigoloff (4712314).

Berger as modified/.discussed above shows a shoe soles and method of using such substantially as claimed except for providing a transparent layer over the bottom of the outsole. Rosen or Sigoloff teaches providing a transparent layer (34 or 26) on an outsole over an area of indicia. It would have been obvious to provide a transparent layer as taught by Rosen or Sigoloff in the shoes and method of Berger to increase the durability and to make the indicia easier to read after the shoes have been worn.

Response to Arguments

4. Applicant's arguments filed 5/14/04 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards the calibrated markings of Berger, shoe size calibrated markings would have been clearly an obvious choice in view of the article being a shoe. In fact it may be unobvious to use a different type of calibrated marking. It is also noted that "Where sole distinction set out in the claims

over prior art is in printed matter, there being no new feature of physical structure and no new relation of printed matter to physical structure, such claims may not be allowed; it is only where claims define either new features of structure or new relations of printed matter to structure, or both, which new features or new relations give rise to some new and useful function, effect, or result, that claims may be allowed" and "sole different over art being in printed matter (indicia), different is substance, language, or meaning of the same whether generally accepted or arbitrary, cannot serve to impart patentability". (Ex parte Gwinn, 112 USPQ 439-449). Contrary to applicants statement on page 12 of applicants arguments, the specific markings do not provide a new feature of physical structure or new relation of printed matter to physical structure, both the markings of Berger and the markings of applicant are used to determine the fit of a shoe.

In response to the arguments directed towards the calibrated markings being a "range of standardized shoe sizes", Berger clearly shows a plurality of calibrated markings and therefore inherently show a "range" of sizes.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (572)272-8300 (**FORMAL FAXES ONLY**). Please identify Examiner Marie Patterson of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Marie Patterson whose telephone number is (571) 272-4559. The examiner can normally be reached from 6AM - 4PM Mon-Wed.



Marie Patterson
Primary Examiner
Art Unit 3728